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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,720	04/16/2004	Luciano Salice	298-240	2182

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UNIONDALE, NY 11553

EXAMINER
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KRAUSE, JUSTIN MITCHELL

ART UNIT	PAPER NUMBER
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3682

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,720	<b>Applicant(s)</b> SALICE, LUCIANO	
	<b>Examiner</b> Justin Krause	<b>Art Unit</b> 3682	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/9/07, 10/8/04, 4/16/04</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Species 1 in the reply filed on July 23, 2007 is acknowledged.

Claim 9 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 23, 2007. Claim 8 is withdrawn as being non readable on the elected embodiment as no positive engagement couples the overrunning coupling in the elected embodiment.

### ***Claim Objections***

Claim 20 objected to because of the following informalities: "te damper" is believed to be a typographical error and will be read as "the damper". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 10-20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 and 10-20 are generally narrative, mixing positively recited structure with functional language such that is not clear what exactly should be given patentable weight, and what the scope of the claims are. For clarity and readability, the examiner suggests re-writing the claims in accordance with 37 CFR 1.75(i). The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Regarding claim 2, "in one direction" and "the opposite direct" lack antecedent basis to the "first" and "second" directions in claim 1. Applicant is advised to maintain consistent directional language throughout the claims.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

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exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation "engagement means", and the claim also recites "in particular helical gearing" which is the narrower statement of the range/limitation.

Also in the present instance, claim 12 recites the broad recitation "rotation damper is provided", and the claim also recites "rotation damper is preferably designed for effective damping in two directions" which is the narrower statement of the range/limitation.

Claim 17, uses the term "it", and it cannot be determined what "it" is. The claim continues with the phrase, "and/or the actuation part or a gear component . . . are/spring loaded" and it cannot be determined what the claim is attempting to recite. There is no limitation preceding the "and/or" that permits the phrase "and/or" to make any sense when immediately followed by a single item and another "or".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-7,10-14, and 16-20, to the extent which they are best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Komeya et al (US Patent 4,660,881) in view of Herbst (US Patent 3,203,525).

Komeya discloses a device for damping movable furniture parts comprising an actuation part (48) held to be moved to and fro, a damper (the assembly as shown in figure 1, 11 or 18) and a gear stage (56 combined with 58 and 60) to translate movements of the actuation part to the damper.

Komeya does not disclose a conical overrunning coupling.

Herbst teaches an overrunning coupling consisting of a pair of conical surfaces, one on a gear element and another on a gear stage for the purpose of selectively engaging a coupling to transmit torque.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Komeya to include a conical overrunning coupling for the desired purpose of selectively transmitting torque as taught by Herbst.

Regarding claim 2 the overrunning coupling is formed by a gear element (Herbst 3) which transmits driving force in one direction and translates motion to another element, couples in one direction and decouples in the opposite direction.

Regarding claims 3, 7, and 19, the coupling engagement surfaces of Herbst are conical.

Regarding claim 4 and 18, the gear wheel is seated on a gear shaft (90) and is capable of axial sliding.

Regarding claims 5 and 20, the gear shaft is constituted by the outer wall of a rotatable part (84) of the damper.

Regarding claim 6, the overrunning coupling couples non-positively.

Regarding claim 10, the gear stage comprises engagement means (teeth on gear 46).

Regarding claim 11, the gear element is seated directly on the damper (fig 11).

Regarding claim 12, a rotation damper is provided (fig 11 or 18).

Regarding claim 13, the damper is free of any restoring means.

Regarding claim 14, the rotation part is axially slidable and is a toothed rack which meshes with the pinion (56).

Regarding claim 16, the gear stage of Komeya is capable of performing the intended function, as no structure has been recited to facilitate this function.

Regarding claim 17, the mechanism is spring loaded (58).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komeya as applied to claim 1 above, further in view of Welch (US Patent 3,327,548).

Komeya does not provide a tooth profile of the gear teeth.

Welch teaches helical gearing for the purpose of engagement of a large number of teeth simultaneously, permitting transmission of heavy loads with smooth engagement and disengagement (Col 1, lines 50-61).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Komeya to use helical gearing as for the desired purpose

of transmitting heavy loads with smooth engagement and disengagement of the gear teeth as taught by Welch.

Examiner's Note: The claims are replete with functional recitations of what the device does, however the claims do not include associated language of how the device performs the function. "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original)." (MPEP 2114). The combination of the prior art is deemed capable of performing the claimed functions as recited.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Krause whose telephone number is 571-272-3012. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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9/24/07  
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SUPERVISORY PATENT EXAMINER